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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,935	09/30/2003	William Michael Russell	5051.514DV	2630

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EXAMINER

STEADMAN, DAVID J

ART UNIT PAPER NUMBER

1656

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,935	Applicant(s) RUSSELL ET AL.	
	Examiner David J. Steadman	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 18-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of the Application

[1] The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1656.

[2] Claims 18-20 are pending in the application.

[3] Applicant's preliminary amendment canceling claims 1-17, filed on 9/30/2003, is acknowledged.

[4] Receipt of an information disclosure statement, filed on 9/30/2003, is acknowledged.

[5] Receipt of a sequence listing in computer readable form (CRF), a paper copy thereof, a statement of their sameness, and a statement that no new matter has been added to the specification by the paper copy of the sequence CRF, all filed on 12/15/2003, is acknowledged.

[6] There is no amendment directing entry of the substitute sequence listing filed on 12/15/2003 into the specification. In order to perfect the requirements for sequence compliance, applicant should include such an amendment in response to this Office action.

[7] The specification is objected to as applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 121 as follows: An application in which the benefits of an earlier application are desired must

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contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

If applicant desires priority under 35 U.S.C. 121 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

Election/Restrictions

[8] Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 18-19, drawn to an isolated beta-glucuronidase protein, classified in class 435, subclass 200.
- II. Claim 20, drawn to an antibody, classified in class 530, subclass 387.9.

[9] The inventions are distinct, each from the other because:

[10] The polypeptide of Group I and the antibody of Group II are related. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially

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different design, mode of operation, function, or effect. See MPEP 806.05(j). In the instant case, the claims of Group I or II do not overlap the scope of the claims of the other Group as evidenced by the distinct structures and functions of the claimed inventions. While the protein and antibody of Groups I and II are comprised of linear, contiguous amino acids, the amino acid sequence of the polypeptide and the antibody each folds into a distinct, three-dimensional structure, thereby imparting distinct functions – the protein's function is beta-glucuronidase activity and the antibody's function is to bind a cognate polypeptide sequence. Additionally, the polypeptide and the antibody are not obvious variants of each other based on the distinct structures and functions of each as noted above. Lastly, the polypeptide and the antibody have materially different functions as noted above.

Because these inventions are distinct for the reasons given above and the search required for Group I or II is not required for the other Group, restriction for examination purposes as indicated is proper.

Conclusion

[11] MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-II are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation

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either separate classification, separate status in the art, or a different field of search.

The inventions of Groups I and II have separate classification and as noted above, each of the inventions requires a separate patent and non-patent literature search requiring a different text and/or sequence search for each Group and thus, co-examination of the inventions of Groups I-II would be a serious burden on the examiner.


[12] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[13] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Thurs, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1656